

**REMARKS**

The Examiner rejected claims 1-2 and 9-10 under 35 U.S.C. §102(b) as allegedly being anticipated by Osder *et al.* (US Patent 5,493,606).

The Examiner rejected claims 3-8 and 11-16 under 35 U.S.C. §103(a) as allegedly being unpatentable over Osder *et al.* (US Patent 5,493,606).

Applicant respectfully traverses the §102 and §103 rejections with the following arguments.

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5 U.S.C. §102(b)

The Examiner rejected claims 1-2 and 9-10 under 35 U.S.C. §102(b) as allegedly being anticipated by Osder *et al.* (US Patent 5,493,606).

Applicant respectfully contends that Osder does not anticipate claim 1, because Osder does not teach each and every feature of claim 1.

As a first example of why Osder does not teach each and every feature of claim 1, Osder does not teach the following feature of claim 1: "a database that contains a plurality of pre-recorded voice prompts"

The Examiner argues that Osder discloses: "a database that contains a plurality of pre-recorded voice prompts (i.e. "storage in records in the VU database to be referenced when playing the prompts," col. 1 lines 60-64; "These **prompt definitions** are interactively generated by the user utilizing VU and are stored in records in the VU database," col. 2 lines 8-23; "The voice for the elements can be recorded through NAP and stored in the NAP voice file. The NAP Message Ids corresponding to the recorded voice elements are stored in a SPIN Data Base (SPINDB)," col. 3 lines 48-60; "SPIN relates the entities that it creates in the SPIN data base to a particular SPIN application," col.6lines 11-31)" (emphasis added)..

In response, Applicant respectfully contends that the preceding citation of Osder discloses storage of **prompt definitions** in a database, but does not disclose storage of pre-recorded prompts in a database. Indeed, it is clear from Osder, col. 1, lines 42-56 that Osder's invention generates a prompts at run time from the prompt definition and therefore does not store the prompt itself in a database. In particular, Osder discloses in col. 1, lines 42-56 and FIG. 1 that a

prompt is a combination of static elements and dynamic elements, which are stored separately from each other. The prompt definition specifies which combination of static and dynamic elements defines the prompt. The dynamic element of the prompt is of course "dynamic" and is therefore unknown until run time. At run time, the dynamic elements for the prompt are known and the prompt is accordingly generated. The example of a prompt depicted in FIG. 1 of Osder is: "You have five new messages", wherein the dynamic element 'five' is inserted between the static elements 'you have' and 'new messages' to generate the prompt at run time. Thus, the prompts are not pre-recorded and are not stored in a database, as required by claim 1.

As a second example of why Osder does not teach each and every feature of claim 1, Osder does not teach the following feature of claim 1: "a call flow instruction that invokes a voice prompt provides a variable that can be read from outside compiled code of the application program".

In "Response to Arguments", the Examiner argues that "a meta-language variable to the Dynamic Element Table is read from outside of the Network Application".

In response, Applicant contends that the Examiner has not identified what this "meta-language variable" specifically is, and in addition, the Examiner has not identified how this "meta-language variable" is provided by a call flow instruction as required by claim 1. In light of the Examiner's lack of clarity and specificity, Applicant does not find the Examiner's argument persuasive. Applicant respectfully requests clarification from the Examiner in relation to the aforementioned "meta-language variable" and how it is provided in a call flow instruction.

As a third example of why Osder does not teach each and every feature of claim 1, Osder does not teach the following feature of claim 1: "an assignment table that assigns a value to the variable to provide an entry point to the database ... that contains a plurality of pre-recorded voice prompts".

Applicant notes that the Examiner has identified "a meta-language variable to the Dynamic Element Table" as the "variable" in claim 1. Therefore, the preceding feature of claim 1 in this third example requires an assignment table that assigns a value to said meta-language variable. In this regard, the Examiner's arguments are vague and therefore not persuasive. Applicant respectfully requests that the Examiner identify as clearly as possible where and how Osder discloses the aforementioned "assignment table", and also the "value" that is allegedly assigned to the meta-language variable.

Based on the preceding arguments, Applicant respectfully maintains that Osder does not anticipate claim 1, and that claim 1 is in condition for allowance. Since claim 2 depends from claim 1, Applicant contends that claim 2 is likewise in condition for allowance.

With respect to claim 9, the Examiner states: "Per claim 9, it is the method version of claim 1, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 1 above."

In response, Applicants traverse the rejection of claim 9 based on Applicants' arguments presented *supra* in conjunction with claim 1 in relation to the rejection under 35 U.S.C. §102(b).

Based on the preceding arguments, Applicants respectfully maintain that Osder does not

anticipate claim 9, and that claim 9 is in condition for allowance. Since claim 10 depends from claim 9, Applicants contend that claim 10 is likewise in condition for allowance.

In addition with respect to claims 2 and 10, Applicant respectfully contends that Osder does not teach the feature: "wherein the database includes a first voice prompt in a first language and a second voice prompt in a second language, wherein the first language and the second language are different".

The Examiner argues: "Osder discloses: - the database includes a first voice prompt in a first language and a second voice prompt in a second language, wherein the first language and the second language are different (i.e. "Index Prompt Tables under three different SPIN applications.., to support three different languages," col. 6 lines 33-46; lines 61-67; col. 7 lines 4-21; col. 8 lines 35-36) as claimed."

In response, in consideration of the antecedent basis for "the database" in claims 1 and 9, Applicant maintains that the database that includes the voice prompts must also include the Index Prompt Tables, which Osder does not disclose. Therefore, the Examiner's argument is not persuasive.

35 U.S.C. §103(a)

The Examiner rejected claims 3-8 and 11-16 under 35 U.S.C. §103(a) as allegedly being unpatentable over Osder *et al.* (US Patent 5,493,606).

Since claims 3-8 depend from claim 1, which Applicant have argued *supra* to be

patentable under 35 U.S.C. §102 over Osder, Applicants maintain that claims 3-8 are not unpatentable under 35 U.S.C. §103(a) over Osder.

Since claims 11-16 depend from claim 9, which Applicant has argued *supra* to be patentable under 35 U.S.C. §102 over Osder, Applicants maintain that claims 11-16 are not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claims 3-8 and 11-16, Applicant respectfully contends that the Examiner's argument for modifying Osder by features specific to claims is not persuasive.

The Examiner argues: "The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences."

In response, Applicant respectfully contends that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Osder in relation to claims 3-8 and 11-16. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art

suggested the desirability of the modification.”). The Examiner has not made any showing of where the prior art suggests the modifications of Osder alleged by the Examiner to be obvious. Thus, the Examiner has provided a reason for the modification of Osder by speculation, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for the modifications of Osder alleged by the Examiner to be obvious, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 3-8 and 11-16.

**CONCLUSION**

Based on the precoding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

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